

### REMARKS:

Reconsideration of the present application, as amended, is respectfully requested.

The pending claims in the present application are claims 1, 3-9, 11-22 and 24-32. Claims 2, 10 and 23 have been cancelled. The independent claims include claims 1, 9, 18 and 31.

In the September 9, 2005 Official Action, the Examiner rejected claims 1, 3-9, 11-17, 31 and 32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 and 36-41 of U.S. Patent No. 6,734,145. The Examiner further rejected claims 1, 3-9, 11-17, 31 and 32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36, 46 and 47 of U.S. Patent No. 6,734,384. In addition, the Examiner also rejected claims 1, 3-9, 11-17, 31 and 32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-13, 15-17, 19-27 and 29-39 of co-pending Application Serial No. 10/667,415. Furthermore, the Examiner also rejected claims 1, 3-9, 11-17, 31 and 32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-12 and 14-20 of co-pending Application Serial No. 10/667,318.

In response, the Applicant is submitting a terminal disclaimer to overcome all of the provisional obviousness-type double patenting rejections.

The Examiner also rejected claims 31 and 32 under 35 U.S.C. 103(a) as being unpatentable over Patel (U.S. Patent No. 5,925,182). According to the Examiner, Patel teaches a suspension comprising oil, glycol and graphite (see Claim 1) which may be used in well bores. The Examiner further states that Patel differs in that the specific example of the combination in claim 31 is not disclosed but it would be obvious to one skilled in the art to utilize a combination of oil and glycol with the graphite in the suspension of Patel. The Examiner also states that the applicant's claim is not seen to distinguish, since a combination of all components would be formed in the additive.

In response to the Examiner, Patel relates to a liquid suspension comprising (at minimum) a liquid carrier (such as oil and glycol), a solid fatty acid or salt, and a solid particulate (such as graphite). Patel teaches that its composition requires each of the

above components “in a stabilizing amount sufficient to produce a stable suspension” (see claim 1). Unlike the present invention, Patel requires the presence of a solid fatty acid or salt in combination with a carrier and graphite to form a stable suspension. Patel teaches away from the present invention, in particular claims 31 and 32 because claim 31 does not require a solid fatty acid or salt to form its stable additive. Patel does not teach nor suggest an additive comprising a first mixture of oil/graphite combined with a second mixture of glycol/graphite wherein the oil and glycol pre-coats the graphite. Furthermore, it would not be obvious to one skilled in the art to utilize Patel to reach the combination in claim 31 since Patel requires the combination of a liquid carrier, a solid fatty acid or salt, and a solid particulate (such as graphite) to form its stable suspension.

In view of the above, it is respectfully submitted that the Examiner’s rejection under 35 U.S.C. 103(a) in view of Patel has been overcome and should be removed.

The Examiner further rejected claims 1, 3-4, 6-9, 11-14, and 15-17 under 35 U.S.C. 103(a) as being unpatentable over Rayborn (U.S. Patent No. 4,063,603) in view of DeBeers (U.S. Patent No. 5,401,719). According to the Examiner, Rayborn teaches an additive comprises copolymer beads (see column 2, lines 48-58) and further teaches that vegetable oil can be added to the drilling fluid. The Examiner further states that Rayborn does not teach graphite but DeBeers teaches the use of graphite to improve lubrication properties of a drilling fluid (see column 2, lines 15-33). According to the Examiner, case law has held that the utility of two or more compositions in combination, for that which they are individually taught useful is not a patentable distinction and that it would be obvious to one of ordinary skill in the art to use the graphite mixture in DeBeers with the vegetable oil and polymer bead of Rayborn, given that such are individually taught as being useful in forming a lubricant for addition to drilling fluids. The Examiner also states that this is particularly true since Rayborn teaches that combinations with other lubricants aid the function in the well bore (column 3, lines 44-49).

In response, Rayborn relates to a method of using plastic beads to reduce the friction between the drill bit, drill string and the well bore. Although Rayborn discloses the use of other lubricant to reduce friction such as vegetable oil, Rayborn discloses that plastic beads are an alternative to other lubricants such as oils (see column 1, lines 66 to column 2, line 15). Rayborn neither teaches nor suggests the combination of the plastic

beads with the oils. In fact, Rayborn teaches away from the combination because the novelty of Rayborn goes to the use of plastic beads (by itself) as lubricants to reduce friction and the vegetable oil is being disclosed as a prior art application as a lubricant for reducing friction.

DeBeers relates to an additive comprising graphite, a silicate and silicone. Although DeBeers suggests the use of graphite (by itself) as a lubricant, the novelty of DeBeers goes to the combination of graphite, silicate and silicone and whereby graphite is the carrier medium of silicate and the silicate is the carrier medium of silicone (see column 2, lines 64-67). DeBeers does not teach or even suggest combining the graphite (by itself without the silicate and silicone) with oil and polymer beads. In fact, DeBeers teaches away from the present invention because it requires the combination of graphite, silicate and silicone and the graphite's primary function in the DeBeer's additive is lubrication.

First and foremost, there must be a basis in the art for combining or modifying any reference. There is no basis in either Rayborn or DeBeers to combine or modify either of the references to arrive at the presently claimed invention. Secondly, references are not combinable or modifiable if their intended function is destroyed. Rayborn is intended to disclose the use of polymer beads (by itself) as a lubricant and DeBeers is intended to disclose the use of the combination of graphite, silicate and silicone. One of the novelties of the present invention is that the polymer beads or the graphite are pre-coated or pre-wet with a carrier such as oils or glycols. The pre-coating or pre-wetting improves the properties of both the polymers and the graphite. Neither Rayborn nor DeBeers, either alone or in combination, teach or suggest combining polymer beads, graphite and a carrier to improve the properties of a drilling fluid additive. In addition, Rayborn and DeBeers, either alone or in combination, does not disclose or suggest pre-coating or pre-wetting graphite and polymer beads with a carrier, such as oils or glycols.

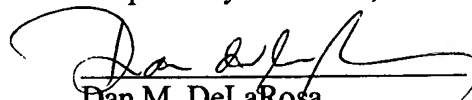
In view of the above, it is respectfully submitted that the Examiner's rejection under 35 U.S.C. 103(a) in view of Rayborn in combination with DeBeers has been overcome and should be removed.

In view of the actions taken and arguments presented, it is respectfully submitted that the present invention is now in condition for allowance.

An early and favorable action on the merits is earnestly solicited.

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Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Dan M. DeLaRosa', written over a horizontal line.

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